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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

JAR-3691-666

Application Number

10/811,309

Filed

March 29, 2004

First Named Inventor

RICHARDSON

Art Unit

1791

Examiner

J. LAZORCIK

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record 37,515
(Reg. No.)

☐ Attorney or agent acting under 37CFR 1.34.
Registration number if acting under 37 C.F.R. § 1.34 _____

Signature

Joseph A. Rhoa

Typed or printed name

703-816-4043

Requester's telephone number

March 30, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

RICHARDSON et al.

Atty. Ref.: 3691-666; Confirmation No. 8273

Appl. No. 10/811,309

TC/A.U. 1791

Filed: March 29, 2004

Examiner: J. LAZORCIK

For: METHOD OF MAKING COATED GLASS ARTICLE, AND INTERMEDIATE
PRODUCT USED IN SAME

* * * * *

March 30, 2010

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to the OG Notice of July 12, 2005, Applicants hereby request a pre-appeal brief review of this case for at least the following reasons.

Claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Stachowiak (U.S. Pat. No. 6,602,608) in view of Medwick (U.S. Pat. No. 6,682,773) and Konda (U.S. Pat. No. 5,254,201). This rejection is respectfully traversed.

The instant rejection improperly uses hindsight to reject the pending claims. The base reference, Stachowiak, contains no motivation to modify its glass substrate based on Medwick's protective coating. However, even in improper combination, this alleged combination fails to meet all the features of claim 1. Neither reference discloses or remotely suggests adhering a flexible protective sheet via an adhesive layer to form a protected coated article, as

acknowledged in the Office Action at page 4, or that following said cutting, edge seaming and washing, peeling the protective sheet off of the top of the surface of the low-E coating to form an unprotected coated article.

Citation to Konda does not cure these fundamental deficiencies. First, one skilled in the art would *not* modify the Stachowiak/Medwick combination based on Konda. Medwick teaches directly away from peelable protective sheets:

[T]he solid peeled film must be properly disposed of. Further, considerable time is required to peel the coating completely off of the substrate surface. For hastily removed peelable coatings, small patches of the peelable coating may remain on the substrate, requiring increased time and labor costs to inspect and remove these small patches.

(Col. 2, lines 21-27 of Medwick). In addition to teaching directly away from modification based on Konda, Medwick's and Konda's "substrates" are vastly different in size. Therefore, deposition techniques and removal techniques of the protective coating/sheet of each reference are not necessarily interchangeable with and/or applicable to the other. Konda, though it does have a peelable sheet, is designed to cover a *much* smaller surface area than Medwick. For instance, Medwick explains that in the glass industry, large glass pieces, e.g. generally greater than about four feet by six feet, are prepared by glass manufacturers and then shipped to fabricators to be cut into smaller pieces. (Col. 1, lines 40-43 of Medwick). Konda, on the other hand, discloses a "substrate" that is a semiconductor wafer having a diameter of four inches. (Col. 4, line 35 of Konda). There is no indication in Konda that it could be used for a significantly larger-scale operation. There is also no indication that if Konda's protective sheet *were* used, it would not face the same problems as disclosed in Medwick. Medwick advises against (teaches away from) peelable coatings. Konda does not disclose or suggest a coating that is capable of use on a large substrate. Konda's protective sheet, by virtue of its incredibly small

size (16 square inches), would not be subject to the same problems disclosed by Medwick with respect to peelable coatings for much larger substrates (24 square feet). Therefore, modification of the Stachowiak/Medwick combination in view of Konda would be directly contrary to the teachings of Medwick. Moreover, such modification would result, according to Medwick, in a coating that is difficult to remove.

In addition to the fact that modification of Stachowiak/Medwick in view of Konda would not work, Applicants respectfully disagree with the Examiner's contention that Konda constitutes analogous art to Medwick because "the disclosed film is applied to a substrate in such a manner to protect the fine structure of a film formed thereon from damage or marring." Konda's protective sheet, again, is designed to cover a semiconductor wafer with a four inch diameter. Medwick's protective coating is designed to protect large (24 square feet) sheets of glass. Application and removal of these respective protective coatings will vary greatly due to the significant difference in substrate size. Despite the fact that both references may disclose some sort of protective coating, the logistics of getting the coatings on and off, as well as way each coating functions, are very dissimilar. Thus, these coatings would not be combined by one skilled in the art. Any allegation to the contrary constitutes the improper use of hindsight.

Moreover, even in improper combination, the three-way combination of Stachowiak, Medwick and Konda still fails to meet all the features of claim 1. The protective sheet of claim 1 is removed subsequent to washing ("following said cutting, edge seaming and washing, peeling the protective sheet off of the top surface of the low-E coating to form an unprotected coated article"). Medwick does not disclose this, and Konda *cannot* disclose this. Medwick's coating is washed off during the aqueous washing stage, and since Konda is directed to a protective film for a semiconductor wafer, it is inapposite and unrelated to protecting a substrate until after

washing it, and does not meet this feature of claim 1. This feature of the method is not accomplished/performed by any of the methods described in the applied prior art references.

In conclusion, Applicants respectfully submit that all claims are patentably distinct from the applied prior art references. (1) Medwick teaches directly away from peelable protective sheets; (2) Konda does not contain a teaching or suggestion regarding how its protective sheet could be used on a large scale, and thus, even if Konda's protective sheet were implemented in Stachowiak/Medwick, it would face the same problems taught by Medwick regarding peelable coatings, due to the large size of the glass substrates requiring these protective coatings/sheets; and (3) finally, even if Stachowiak/Medwick were (incorrectly) modified based on Konda, no applied prior art reference discloses following said washing, peeling the protective sheet off.

In view of the foregoing, reconsideration and withdrawal of all claim rejections are earnestly solicited. If any minor matter remains to be resolved, the undersigned may be contacted with regard to the same.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____

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